

REMARKS**I. General**

The specification has been amended. Claims 1-13, 15, and 17-29 stand rejected under 35 U.S.C. § 103(a). Claims 1-13 and 15-29 are pending in this application.

II. Objection to the Specification

The specification stands objected to as failing to provide proper antecedent basis for the claimed subject matter as the term “agent” does not appear in the specification. Applicant has amended the specification, specifically the Summary of the Invention to include the language recited in claim 13, as originally filed. Claims 13-18 describe an “agent” as used in claims 1-8. M.P.E.P. 608.01(l) clearly states that the original claims are part of the disclosure and as such satisfy the written description requirement of 35 U.S.C. § 112, first paragraph. No new matter has been added as the language added to the Summary of the Invention was in the application as originally filed as recited in claim 13. Therefore, Applicant respectfully requests the objection to the specification be withdrawn.

III. Rejection under 35 U.S.C. § 103 (Pepe)

Claims 1-2, 4-6, 8-11, 13, 15, 17, and 19-29 stand rejected under stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Pepe et al. (5,742,905, hereinafter Pepe).

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. § 2143. Applicant asserts that the rejections do not satisfy the first criteria.

Claims 1 and 5 define an agent adapted to compare characteristics of e-mail messages received for the subscriber to specific message characteristics provided by the subscriber and pre-stored on the server, to alert the subscriber when a characteristic match is found, and to execute instructions received from the subscriber in response to the alert.

The Office Action at page 2 admits that Pepe does not disclose the limitations of claims 1 and 5 regarding email, then alleges the limitations are obvious in view of Pepe through the operation of CallCommand directed to voicemail. Applicant respectfully disagrees with Examiner's modification of Pepe. The mere fact that references can be modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

It is clear that the CallCommand functionality, which includes the features used by the Examiner, is separate from the email functionality. *See*, column 10, line 34 through column 11, line 32 separately describing email functions and CallCommand functions, or column 14, lines 57-65, showing a table with separate CallCommand (CC) and email systems (options 2 and 3, respectively). Pepe clearly contemplated both email functionality and the CallCommand functions cited by the Examiner but specifically chose (for either technical or design reasons) not to include email in its CallCommand functionality. Further, there is no mention in Pepe, other than the general "wireless technologies make subscribers constantly available" language used by the Examiner, of the desirability to include email in the CallCommand functionality.

Clearly, if Pepe suggested the desirability of the combination, Pepe could have included the email functionality in the CallCommand functions, or suggested the desirability of that functionality in its extensive descriptions of its system. Without such teachings in Pepe, Applicant respectfully asserts that Pepe teaches away from the modification proposed by the Examiner.

As Pepe was in possession of both the CallCommand functionality and email technology, both wireline and wireless, yet specifically did not combine the two, nor even suggest the combination in its extensive disclosure, Applicant respectfully asserts that there is no motivation to modify Pepe as suggested by the Examiner. Impermissible hindsight may not be used in a conclusion of obviousness and as such, knowledge gleaned only from Applicant's disclosure may not be used, see M.P.E.P. 2145, paragraph X.A. and *In re McLaughlin*. As Pepe teaches away from the modification described by the Examiner, the

only motivation to make the modification is knowledge gleaned only from the Applicant's disclosure. As there is no proper motivation to modify Pepe as required by the Examiner, claims 1 and 5 are allowable over the rejection of record.

Claim 9 defines a method comprising receiving instructions for forwarding stored messages from a subscriber in response to an alert and forwarding the stored messages for which a match is found to destinations according to the instructions provided in response to the alert. Claim 13 defines an agent comprising a save facility adapted for storing matched messages against future distribution instructions, the future distribution instructions received from a subscriber in response to an alert. Claim 19 defines a method comprising receiving a reply from a subscriber in response to an alert, the reply comprising instructions for a message and processing the message according to the instructions.

With regard to claims 9, 13 and 19, the Examiner proposes the same modification using the same motivation as described with respect to claims 1 and 5. Office Action pages 3, 4 and 5, respectively. As discussed above in the response to the rejections of claims 1 and 5, there is no motivation to make modifications to Pepe set forth by the Examiner. Without such motivation claims 9, 13 and 19 are allowable over the rejection of record.

Claims 2, 4, 6, 8, 10-11, 15, 17, and 20-29 each depend directly or indirectly from one of independent claims 1, 5, 9, 13, or 19 and inherit all the features and limitations of their respective base claim. Thus, claims 2, 4, 6, 8, 10-11, 15, 17, and 20-29 each set forth features and limitations not found in Pepe and were improperly rejected, as discussed above. Therefore, Applicant respectfully asserts that for at least the above reasons, claims 2, 4, 6, 8, 10-11, 15, 17, and 20-29 are patentable over Pepe and requests the 35 U.S.C. § 103(a) rejection be withdrawn.

IV. The 35 U.S.C. § 103 Rejections (Pepe in view of Fuller)

Claims 3, 7, 12, and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Pepe in view of Fuller et al. (6,545,589).

Claims 3, 7, 12, and 18 each depend directly or indirectly from one of independent claims 1, 5, 9, or 13 and inherit all the features and limitations of their respective base claim.

Thus, the modification of Pepe required to support the rejections of claims 3, 7, 12, and 18 is improper, as discussed above. Fuller is not relied upon as teaching these limitations. Therefore, Applicant respectfully asserts that for at least the above reasons, claims 3, 7, 12, and 18 are patentable over Pepe in view of Fuller and requests the 35 U.S.C. § 103(a) rejection be withdrawn.

CONCLUSION

In view of the above, applicant believes the pending application is in condition for allowance.

Applicant believes no fee is due with this response. However, if a fee is due, please charge Deposit Account No. 06-2380, under Order No. 66360/P001D1/10402620 from which the undersigned is authorized to draw.

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Respectfully submitted,

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